

Application No. 09/464,348
Amendment "C" dated April 21, 2004
Reply to Office Action mailed November 21, 2003

REMARKS

The latest Office Action, dated November 21, 2003, considered claims 1, 9-12, 20-22 and 33-42. Claims 1, 9-12, 20-22 and 33-42 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Thurlow (U.S. Patent No. 5,917,489) in view of Gainey (U.S. Publication Application No. US 2002/0099681 A1)¹. By this paper, new claims 43-45 have been added to recover claimed embodiments that were previously claimed in cancelled claims 20-22.² Accordingly, claims 1, 9-12 and 33-45 now remain pending, of which claims 1 and 12 are the only independent claims at issue.

Initially, Applicants respectfully submit that that a *prima facie* case of obviousness has not been established in the latest action. In particular, the Examiner has failed to show or even allege that each and every element recited in the claims is taught by the art of record, either singly or in combination, as explained by the following.

Both of the independent claims (1 and 12) recite a method that includes:

(a) storing a standard command based on a standard Internet protocol, (b) storing a user-created command based on extensions of the standard Internet protocol, both of the commands being used for manipulating a message, (c) "assigning a user-defined priority to the user-created command *relative to* an assigned priority of the standard command, *wherein the user-defined priority is assigned only after the user-created command is registered in one or more databases that store the standard command*,"³ and (d) "executing at least one of the standard command and the user-created command in order of assigned priority."

The Examiner has acknowledged in the latest action that Thurlow does not disclose:

(c) assigning a user-defined priority to the user-created command *relative to* an assigned priority of the standard command, *wherein the user-defined priority is assigned only after the user-created command is registered in one or more databases that store the standard command*, and

¹ Although the prior art status of the cited art is not being challenged at this time, Applicants reserve the right to challenge the prior art status of the cited art at any appropriate time, should it arise. Accordingly, any arguments and amendments made herein should not be construed as acquiescing to any prior art status of the cited art.

² There appears to be some confusion regarding the status of claims 20-22, which were shown to be cancelled in the latest listing of the claims provided in Amendment B. Nevertheless, the Examiner appears to have still considered them as pending following the latest action. To correct any misunderstanding, the current listing of claims again reflect that claims 20-22 have been cancelled, while new claims 43-45 have been added to claim the same subject matter of cancelled claims 20-22.

³ Support for this claim element, which was added by amendment in the last response, includes the disclosure found on p. 17, ln. 3 - p. 18, ln. 2 of Applicant's specification.

Application No. 09/464,348
Amendment "C" dated April 21, 2004
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(d) executing at least one of the standard command and the user-created command in order of assigned priority.

The Examiner also fails to show or even allege that Gainey discloses, suggests or motivates the assignment of a user-defined priority to a user-created command *relative* to an assigned priority of a standard command, and *wherein the user-defined priority is assigned only after the user-created command is registered in one or more databases that store the standard command*, as recited in the claims.

Instead, the latest action merely restates the grounds of rejection that were made in the Final Office action (paper 13) before the claims were even amended to recite the aforementioned claim element. The latest action fails to consider or give any deference whatsoever to the new claim amendments and remarks provided in the latest response that clearly distinguish the art of record from the pending claims for at least the foregoing reasons.

Therefore, a *prima facie* case of obviousness has not been established in the latest action, inasmuch as the Examiner has not shown or even alleged that the art of record discloses, suggests or motivates the assignment of a user-defined priority to a user-created command *relative* to an assigned priority of a standard command, *wherein the user-defined priority is assigned only after the user-created command is registered in one or more databases that store the standard command*, as claimed in combination with the other recited claim elements.

One benefit of enabling a user to set the priority of the registered user-defined commands, as disclosed in the specification, is that this type of prioritization can allow the user-defined commands to augment and bypass standard default commands, thereby enabling a user to add or remove features of an email system to create a full-featured, individually customized email system. (p. 9, ll. 2-8; p. 16, ll. 17-19). Furthermore, one benefit of enabling a user to set the priority after the user-created command is registered in the databases is that it allows the user to subsequently define and modify the level of priority for a given command. (p. 16, ln. 11).

At this time, Applicant would also like to remind the Examiner of the arguments made in the last response that described how Gainey actually appears to teach away from assigning priorities to commands in the manner recited in the claims.

For example, in contrast to the claimed embodiments, Gainey teaches that the priority for determining the order in which rules are implemented is uncertain and may only possibly be

Application No. 09/464,348
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dependent upon a rule's position or order of placement within a rule's list. ¶ [0034], [0044]. Accordingly, Gainey's priority is not truly user-defined inasmuch as some rules automatically take priority over the list of customized rules, regardless of the placement of the rules in the list. ("some rules, however, take priority over order." ¶ [0044]; see also ¶'s [0034], [0045]-[0051]).

Furthermore, even assuming, *arguendo*, that Gainey did allow the assigning of user-defined priority for user-created commands relative to the priority of standard rules, which it doesn't, Gainey clearly fails to teach that the commands are executed in order of assigned priority, as claimed. Instead, the priority of the user-defined rules is trumped or overridden by the standard default rules identified in paragraphs [0045]-[0051].

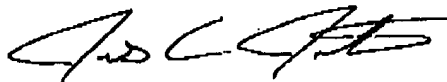
Gainey also fails to suggest or disclose that the user-defined priority is assigned only after the user-created command is registered in one or more databases that store the standard command. In fact, as mentioned above, the Examiner has failed to even alleged that Gainey teaches this element, while at the same time explicitly stating this is not taught by Thurlow.

Accordingly, for at least the foregoing reasons, Applicant respectfully submits that all of the pending claims 1, 9-12 and 33-45 are distinguished from the art of record, and are in condition for prompt allowance, even without amendment.

In the event that the Examiner finds remaining impediment to a prompt allowance of this application that may be clarified through a telephone interview, the Examiner is requested to contact the undersigned attorney.

Dated this 21 day of April 2004.

Respectfully submitted,



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